



1635
Image

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Where Application of: Ikunoshia KATO et al

Application No.: 09/937,375

Filed: September 24, 2001

For: GENE THERAPEUTICS

Confirmation No.: 8012

Customer Window, Mail Stop **NON-FEE AMENDMENT**
THE COMMISSIONER OF PATENTS AND TRADEMARKS
Arlington, VA 22202

Art Unit: 1635

Examiner: J. Angell

Washington, D.C.

Atty.'s Docket: KATO=18

Date: November 10, 2003

MONDAY

Sir:

Transmitted herewith is a [XX] REPLY TO RESTRICTION AND ELECTION REQUIREMENTS in the above-identified application.

- [] Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted
[] A verified statement to establish small entity status under 37 CFR 1.9 and 1.27 is enclosed.
[] No additional fee is required.

The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	* 143	MINUS	** 143	
INDEP.	* 4	MINUS	*** 6	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 9	\$
x 43	\$
+ 145	\$
ADDITIONAL FEE TOTAL	
\$	

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 18	\$
x 86	\$
+ 290	\$
TOTAL	
\$	

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

[XX] Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- [] First - \$ 55.00
[] Second - \$ 210.00
[] Third - \$ 475.00
[] Fourth - \$ 740.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

- [] First - \$ 110.00
[] Second - \$ 420.00
[] Third - \$ 950.00
[] Fourth - \$ 1480.00

Month After Time Period Set

[] Less fees (\$) already paid for ___ month(s) extension of time on _____.

[] Please charge my Deposit Account No. 02-4035 in the amount of \$ _____.

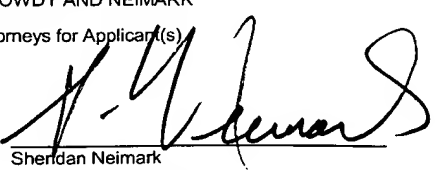
[] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$ _____.

[] A check in the amount of \$ _____ is attached (check no.).

[XX] The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK

Attorneys for Applicant(s)

By: 
Sherdan Neimark
Registration No. 20,520

Facsimile: (202) 737-3528
Telephone: (202) 628-5197



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: KATO=18

In re Application of:)	Art Unit: 1635
IKUNOSHIN KATO)	
)	Examiner: J. E. ANGELL
)	
Appln. No.: 09/937,375)	Washington, D.C.
)	
Nationalized: September 24, 2001)	Confirmation No. 8012
)	
I.A. No.: PCT/JP00/01533)	
I.A. Date: March 14, 2000)	
)	
For: GENE THERAPEUTICS)	November 10, 2003
)	MONDAY

REPLY TO RESTRICTION AND ELECTION REQUIREMENTS

Customer Window, Mail Stop Non-Fee Amendment

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

Replying to the restriction and election requirement Office Action mailed October 8, 2003, and in view of the fact that the applicants must make elections even though they traverse the requirements, applicants hereby respectfully and provisionally elect Group II, presently claims 14-26 and 46-50, drawn to a gene therapy method, with traverse and without prejudice.

As regards the election of species requirement, applicants hereby provisionally and respectfully elect "cells"

as the species of functional substance with affinity for the target cell, with traverse and without prejudice. The claims specifically readable on the elected species are claims 14, 15, 19-22, 25, 26 and 46-50; and per the office action, claims 1-25, 40, and 42-50 are generic.

First, the requirements are traversed on the basis that restriction and election practice do not apply in view of the fact that the present application is the U.S. national stage of a P.C.T. application. This is of course recognized by the examiner who says that Groups I and II do not relate to a single general inventive concept under P.C.T. Rule 13.1 because they lack the same corresponding special technical features in view of U.S. patent 5,830,880. Applicants respectfully disagree, as U.S.P. '880 does not disclose (does not anticipate) all of applicants group I claims.

Applicants also rely on the second paragraph of M.P.E.P 803 which **requires** an examiner to examine plural inventions in a single application, even though the requirement is correct, if it would not constitute a "serious burden" to do so. NO separate classification has been alleged by the PTO. Applicants believe that the examination of Group I along with Group II would not constitute a serious burden. As regards the species election, at least **some** of the non-

Appln. No. 09/937,375
Amd. dated Monday, November 10, 2003
Reply to Office Action of October 8, 2003

elected species should be searchable and examinable without
"serious burden".

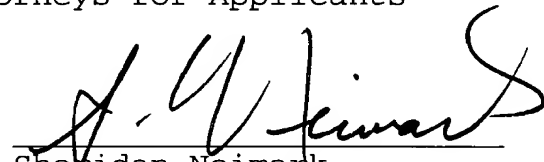
Applicants do not understand the position expressed
in paragraph 3 of the Official Action to the effect that the
species are deemed to lack unity of invention. To the
contrary, they are linked by the generic claims.

Applicants respectfully request withdrawal of both
the restriction and the election requirements, and examination
of all the claims on the merits.

Applicants respectfully await the results of a first
examination on the merits.

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicants

By


Sheridan Neimark
Registration No. 20,520

SN:jec:ft:jaa
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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